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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 763

LEON F. SHACKELL,

Petitioner,

vs.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

LEON F. SHACKELL,
Petitioner, Pro Se.

627 East 83rd Street,
Chicago 19, Illinois,
May 9, 1952.

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Petitioner, Leon F. Shackell, prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered on February 18, 1952, in this case *sub nom. In the Matter of the Application of Leon F. Shackell.*

OPINION BELOW.

The opinion of the court below (R. 85-100) is reported *sub nom. Application of Shackell,* in 194 F. 2d 720, and *In re Shackell,* in 93 U. S. P. Q. 34.

JURISDICTION.

The judgment of the Court of Customs and Patent Appeals was entered on February 18, 1952. (R. 101.) The jurisdiction of this Court is invoked under 28 U. S. C., Sections 1256 and 2101 (c).

STATEMENT.

On May 17, 1944, petitioner filed in the United States Patent Office an application for patent for a composition of matter, serial No. 536,054, presently entitled "Germicide." (R. 3-42.) The Primary Examiner (R. 45, 46) finally rejected claims 649, 650, and 651 (R. 83, 84), all of the claims now pending. The final rejection was affirmed by the Board of Appeals (R. 55-58); and the decision of the Board was affirmed in the judgment (R. 101) now sought to be reviewed. The opinion of the court below, in which the rejected claims are reproduced (R. 87-89), appears at pages 85 to 100 of the record. For ready reference the rejected claims are printed as Appendix A, *infra,* pages 23 to 25; each claim, however, being broken down into recitals which are lettered in bold face in the margin.

Each of the claims is drawn to a substantially water-free, germicidal composition that is adapted as such for direct local application, comprising, in substantially homogeneous physical admixture, a highly caustic phenol and a nitrogenous polar material (Appendix A, *infra,* pp. 23-25, recitals A to D); the polar material being defined by a number of limiting characteristics set forth in each claim. (Recitals E to I.) The phenol—typified by carbolic acid (R. 4, 5; cf. R. 92)—is the essential germicidal agent, but by itself, or even when in dilute solution in water (R. 44), is corrosive to tissues when applied directly thereto. The

nitrogenous polar material—sometimes designated as causticity-reducing agent and as phenol-tempering agent (R. 9)—serves to reduce or to eliminate the causticity of the phenol without proportionately reducing its germicidal power. About 196 distinct nitrogenous compounds, distributed throughout many classes—cf. R. 92, 93—are disclosed in the specification as effective phenol-tempering agents.

Having reference to Appendix A, *infra*, pages 23-25: Claim 649, the broadest claim, is drawn generically to the use of a nitrogenous polar material. (Recital D.) Claim 650 is a generic claim, but narrower in scope than claim 649 in that the polar material is limited to an amide. (Recital D of claim 650.) Claim 651, is a specific claim; the polar material being limited therein (recital D of claim 651) to the single compound acetanilid—the second one of the amides disclosed in Example 5. (R. 20, 21.)

Petitioner's use in his application (*e. g.*, R. 8) of the terms "anionoid" and "cationoid," to characterize certain compounds, radicals or elements, is based upon the Lapworth-Robinson classification, discussed at pages 1859 and 1860 and illustrated in Table XV of *Gilman's Organic Chemistry—An Advanced Treatise.* (R. 78, 79; cf. footnote, R. 90.)

The claimed invention is an outgrowth of a series of discoveries made by petitioner (R. 8)—namely, (1) that nonpolar hydrocarbons (containing only the elements carbon and hydrogen) exhibit no detectable activity as phenol-tempering agents; (2) that compounds in which all of the polar radicals are anionoid—that is, carry negative electrical charges—are particularly effective in reducing the corrosiveness of a caustic phenol; (3) that compounds, wherein all or a preponderance of the polar radicals are cationoid—that is, carry positive electrical charges—ex-

hibit little, if any, capacity to temper a caustic phenol; and (4) that compounds, which contain both anionoid and cationoid radicals (cf. Example 12, R. 33, 34) may be effective phenol-tempering agents, provided, that their state of molecular polarization is preponderantly anionoid in character. These discoveries by petitioner were not suggested by anything known in the prior art. In fact, the court below has expressly assumed that petitioner's development of his claimed composition required the exercise of the inventive faculty. (R. 97.)

A summary of petitioner's inventive concept (R. 38-40) was quoted from his brief by the court below. (R. 90, 91.) The physico-chemical principle, which underlies his concept, is postulated by petitioner (R. 38, 39) as involving the formation of physical orientation complexes through electrostatic attraction between positive poles of phenol molecules and negative poles of phenol-tempering agents; such orientation polarization being likened to the selective positioning toward each other of two freely movable small bar magnets when brought within their mutual spheres of influence.

Petitioner's reduction to practice of his claimed composition as a germicidal, fungicidal and insecticidal agent in infections and infestations of the skin is described in the specification, beginning at the bottom of page 37 of the record.

The Primary Examiner and the Board of Appeals rejected each of the claims here involved for anticipation (R. 52, 53, 56, 57) by each of two non-patent publications (Hrynakowski et al. and Wood-LaWall, R. 69-77, 81); and rejected generic claims 649 and 650 (Appendix A, *infra*, pp. 23, 24) as too broad, indefinite and functional, and as not properly defining the invention. (R. 54, 57, 58.) Those grounds of rejection were sustained by the court below.

The two issues of anticipation and of improper claiming will be discussed separately.

The issue of anticipation. The court below states (R. 90) that:

> "* * * as to the rejection based on prior art, or 'old composition' as the Primary Examiner expressed it, just two references are cited—the Wood-LaWall and the Hrynakowski published articles. * * *"

The Hrynakowski et al. reference (R. 69-72) consists of the first four pages only of a paper published in a Polish chemical journal in 1938. A translation of the cited pages appears at pages 73 to 77 of the record. Of Hrynakowski the Examiner states (R. 53, 93):

> "* * * The reference shows phase diagrams giving the freezing points of various mixtures of phenols with acetanilid and acetamide. * * *"

The Wood-LaWall (Dispensatory) reference (R. 81), under a section relating to the "Incompatibilities" of acetanilid—which precedes the section devoted to its "Uses"—contains the bare statement that:

> "* * * when it is triturated with phenol, thymol, resorcinol, chloral hydrate, and many other organic drugs it forms a eutectic mixture which liquefies. * * *"

The court below quotes (R. 93, 94) the holdings of the Examiner (R. 53, 54) and of the Board of Appeals (R. 56) that petitioner's claims are anticipated by eutectic mixtures described in the Hrynakowski and Wood-LaWall references. A simplification of the issue of anticipation renders it unnecessary to go into the technical aspects of eutectic mixtures—that is, those of lowest melting or freezing points—further than to say that the Examiner and the Board of Appeals probably have assumed that the eutectic mixtures of the references were homogeneous and liquid

at room temperature, and so would come within petitioner's claims.

A principal contention of the petitioner is based upon the fact—which is not denied by any of the tribunals below—that neither of the Hrynakowski and Wood-LaWall publications describes or even suggests any practical use for the compositions therein disclosed. Indeed, a highly material admission by the Primary Examiner in this connection—namely, that Hrynakowski "does not disclose a use of the composition or any hint of the inventive concept" (R. 53)—appears, from the following facts of record, to have been disregarded intentionally by the court below.

In its opinion (R. 93) the court quoted all but two sentences of what the Primary Examiner had to say (R. 53, 54) about the Hrynakowski and Wood-LaWall references under the caption "OLD COMPOSITION." The two sentences which the court omitted from the body of the first paragraph of the matter so quoted, relating to the Hrynakowski reference (R. 53), read as follows:

> "Applicant's attack upon this reference is summarized at the center of page 44 of the brief. It is submitted that the fact the reference does not disclose a use of the composition or any hint of the inventive concept does not in any way detract from the anticipatory value of the reference."

That the court's omission of such a crucially material admission by the Primary Examiner was no mere inadvertence is indicated by the court's substitution of asterisks (R. 93, near the middle of the page) for the sentences thus omitted. The facts thus admitted by the Examiner were not disturbed by the Board of Appeals in its decision. (R. 55-58.)

Although the court below evidently intended to disre-

gard the Examiner's admission, it went on in its opinion to say (R. 94) that:

> "Appellant's brief devotes several pages to a discussion of the Hrynakowski and Wood-LaWall articles in disparagement of their value as references, but *it is specifically conceded* that 6 out of 30, or 20 per cent, of Hrynakowski's mixtures used in his experiments, 'were homogeneous and liquid at room temperature, and so *would come within the terms of appellant's claims.*' (Italics supplied.)"

Petitioner made that concession because, in the fourth of his earlier-filed reasons of appeal (R. 59, 60), he was relying upon the aforequoted admission by the Examiner to show that, under a proper application of Section 4886, R. S., the Hrynakowski publication could not constitute a valid anticipation of the claims. The court below, however, went inexorably ahead to affirm rejection of the claims on the prior art; saying, *inter alia* (R. 96), that:

> "• • • The applicable law is dependent on the facts, and the facts which are conceded by appellant render practically all of the many authorities which he cites irrelevant to his case."

Among the reasons advanced by petitioner hereinafter for grant of the writ of certiorari is that the holding of the court below on the issue of anticipation is not based upon a fair and impartial consideration of material facts appearing in the record, which either are admitted or are undisputed. In any event, however, the issue of anticipation is reduced to a question of law—namely, whether or not the court below has properly construed and applied the provision in Section 4886, R. S., relating to a prior description of a claimed invention in any non-patent, printed publication.

The issue of improper claiming. This issue involves only the generic claims 649 and 650. (R. 83, 84, 87, 88, Appendix

A, *infra,* pp. 23, 24.) The treatment of this issue by the court below is very sketchy; being limited—other than by affirmance of the Board's decision—to an oblique reference to a thought expressed by the Primary Examiner (R. 96, first paragraph) and to holdings, in substance, that recitals I and J (Appendix A, *infra,* pp. 23, 24) are mere statements of result, which do not affect the patentability of the claims. (R. 91, 92.)

Since petitioner has discovered the conditions which determine whether or not a given polar material, containing both anionoid and cationoid radicals, can be an effective phenol-tempering agent, he has coined the phrase "preponderantly anionoid in molecular structure" (Recital E, Appendix A, *infra,* pp. 23, 24) as a shorthand expression by which to define one of the essential limitations on the polar material in his claims. Petitioner, however, does not leave to one skilled in the art to have to determine, simply from a knowledge of its chemical structure, whether or not a given nitrogenous polar material—other than the nearly 200 effective nitrogenous phenol-tempering agents disclosed in his specification—would be preponderantly anionoid in molecular structure; for it would possess such a structure, within the meaning of the application, if it conformed to a quantitative standard, test or condition, which is set forth in the specification (R. 14, last full paragraph), and which is carried into each of the claims as recital I. (Appendix A, *infra,* pp. 23, 24.)

QUESTIONS PRESENTED.

1. Under a proper construction of Section 4886, Revised Statutes, 35 U. S. C., § 31, can the disclosure of an embodiment of a later-claimed invention in a prior, nonpatent, printed publication constitute a valid anticipation of such claimed invention,

(a) Where the publication does not disclose substantially the same invention, in completed or perfected form, as having been known or used by others before its invention or discovery by the later claimant?

(b) If all of the information contained in the publication would be insufficient to support the grant of a patent thereon—as where the publication lacks disclosure of any inventive conception, and of any suggestion of a practical use for the therein described embodiment of the claimed invention?

(c) Where the publication furnishes nothing more than a description of experiments to determine or to demonstrate the operations of certain natural laws, and nothing more than a starting point for further experiments and research?

2. Under a proper construction of Section 4888, Revised Statutes, 35 U. S. C., § 33, is a claim to a composition of matter—comprising a plurality of chemically different ingredients—rejectable for failure to meet the statutory requirements as to particularity and distinctness in claiming the invention,

(a) Where limitations in the claim define physical characteristics and chemical properties of the composition and of the ingredient which is essential to novelty, and define the coaction between the ingredients?

(b) Where the essential inventive feature in the claim resides in a particular molecular structure of one ingredient—of which ingredient the specification discloses many operative examples—where said molecular structure is defined in the specification and in the

claim by a coined expression, and where the existence of that structure in a given compound is determinable by a ready test, which also is described in the specification and is recited in the claim?

3. Where an essential inventive feature in a generic claim to a composition of matter resides in one of its ingredients, where the specification discloses many individual, operative examples of that ingredient, and where limitations in the claim define its requisite physical and chemical attributes, is the claim, if otherwise valid, entitled to cover, as equivalents of said ingredient, compounds other than those disclosed in the specification, but having substantially the same attributes, performing substantially the same function in the composition, and effecting substantially the same result, if exercise of the inventive faculty is not required to demonstrate the interchangeability of such compounds with the operative examples of the ingredient as so disclosed?

4. Did it constitute reversible error for the court below to base its holding of anticipation on petitioner's concession as to what the Hrynakowski publication discloses, where the court knowingly omitted any mention of, and neglected to give any effect to, the admission of the Primary Examiner that said publication does not disclose a use of the composition or any hint of the inventive concept?

The errors specified hereinafter, which are set forth in Appendix B, *infra*, pages 26 to 28, are intended to bring into focus certain facets of the foregoing questions.

REASONS FOR ALLOWANCE OF THE WRIT.

The primary reason relied upon by petitioner for allowance of the writ of certiorari is the lower court's application, without warrant, of arbitrary and artificial rules of interpretation to certain plain and unambiguous provisions of the patent statutes which are relevant to the issues of anticipation and of improper claiming (*Topliff* v. *Topliff*, 145 U. S. 156, 171, 36 L. Ed., 658, 664); thus "indicating a purpose to change the law by judicial action". (*Bate Refrigerating Co.* v. *Sulzberger*, 157 U. S. 1, 36, 37, 39 L. Ed. 601, 611.) For example, no decision of this Court is cited in the opinion of the court below. (R. 85-100.) Indeed, cases cited to the single and inapposite point that a new use is not patentable (R. 99, 100) are the only decisions which are cited by the court. Otherwise, a succession of holdings of the court, adverse to petitioner, are matters solely of judicial fiat.

The first to be taken up will be the court's holdings on the issue of anticipation, which involve the proper application of Section 4886, R. S., as a matter of law to undisputed facts. (*Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 275, 93 L. Ed. 672, 677.)

1. The court below (R. 96, 97) quoted the following from Section 4886, R. S., as amended, 35 U. S. C., § 31, as being pertinent to the instant case:

> "'Any person who has invented or discovered any new * * * composition of matter, or any new and useful improvements thereof * * * not known or used by others in this country, before his invention or discovery thereof, and *not* * * * *described in any printed publication in this or any foreign country*, before his invention or discovery thereof * * * may * * * obtain a patent therefor.' (Italics supplied.)"

In the matter so quoted the court omitted the phrase "and useful" after the first occurrence of "new".

The court below quoted (R. 99) from its opinion in the case of *In re Crosley*, 159 F. 2d 735, that

> "• • • 'this court is committed to the doctrine that where a product is clearly disclosed in a publication, • • • the disclosure of the composition is sufficient to anticipate a claim therefor,' • • •."

Such an arbitrary construction of Section 4886, R. S., supported only by the court's citation of its own decisions, if permitted to stand, cannot but result in serious and unreasonable consequences to that branch of chemical industry which is devoting time, money, materials and the energies of trained personnel to the invention or discovery of new and useful compositions of matter. Indeed, there is no foretelling how far the court below might extend that doctrine, the necessary effect of which is to undermine the primary purpose of the patent laws,—namely, the advancement of the useful arts.

Petitioner advances the following as decisive reasons why the court below has misconstrued and misapplied Section 4886, R. S., in fundamental respects:

(a) Having reference to the foregoing quotation by the court below from Section 4886, R. S.,—as corrected,—the primary subject of the verb phrase "not described in any printed publication" is the "new and useful • • • composition of matter" which the patent claimant "has invented or discovered". The plain meaning, therefore, of that provision is that the claimed composition can be anticipated by a description in a prior, non-patent, printed publication only if the description discloses essentially the same useful invention or discovery as that sought to be patented, and not the mere prior existence of the composition, *per se*, as held, in effect, by the court below. (R.

97-99.) In short, the prior published description must disclose some designed practical use of the claimed composition, which use embodies an inventive conception.

(b) The court below states (R. 98) that

> "Appellant presents the contention as to lack of any showing in the references of utility and dwells upon the matter of reduction to practice in a number of sub-paragraphs. * * *"

The court's subsequent rejection of that contention further demonstrates its misconstruction of Section 4886, R. S., and its conflict with applicable decisions of this Court.

In *Corona Cord Tire Co.* v. *Dovan Chemical Corp.*, 276 U. S. 358, 382, 383, 72 L. Ed. 610, 619, this Court held a Weiss patent in suit to have been anticipated by the prior use by one Kratz of diphenylguanidine (D.P.G.) as an accelerator of vulcanization of rubber; this Court saying, with reference to Kratz's tests with D.P.G., that

> "* * * It was the fact that it would work with great activity as an accelerator that was the discovery, and that was all, and the necessary reduction to use is shown by instances making clear that it did so work, and was a completed discovery." (Citing cases.)

Neither of the Hrynakowski and Wood-LaWall publications comprehends the discovery that any of the compositions disclosed therein will work in any practical manner; much less the necessary reduction to use to provide a completed discovery.

(c) Petitioner's eighth reason of appeal to the court below (R. 60) was that neither of the Hrynakowski and Wood-LaWall publications can constitute a valid anticipation, because neither publication could support an applica-

tion for patent. The court, however, in effect, rejected that contention after assuming (R. 99, first sentence) that

> "• • • appellant regards a publication as being somewhat akin to a patent application. • • •"

The court thereby construed Section 4886, R. S. in a way probably in conflict with applicable decisions of this Court.

In the case of *Seymour* v. *Osborne,* 11 Wall. (78 U. S.) 516, 554, 555, 20 L. Ed. 33, 42, this Court rejected as evidence of prior invention what was contained in a British non-patent publication, and held that the description in such a publication, in order to constitute a valid anticipation of a later invention, must enable those skilled in the art

> "• • • to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. • • •"

To the same effect was the decision of this Court, with reference to a prior printed publication, in *Bates* v. *Coe,* 98 U. S. 31, 44, 45, 25 L. Ed. 68, 75.

Petitioner respectfully submits, therefore, that the writ of certiorari ought to be granted for the purpose of determining, *inter alia,* whether or not the authority of the early cases of *Seymour* v. *Osborne* and *Bates* v. *Coe* should be reaffirmed,—at least so far as they hold that the information disclosed in a prior, non-patent publication must teach those skilled in the art as fully as would be required in the case of a prior patent. Since a patent is invalid if it fails to disclose a practical and useful invention (*Beidler* v. *United States,* 253 U. S. 447, 453, 64 L. Ed. 1006, 1009), it must follow that a non-patent publication is devoid of force as an anticipation if it likewise fails to disclose a practical and useful invention.

(d) In its opinion (R. 99) the court states that

> "Appellant, however, insists here, in substance, that the researchers did not recite in the references nor disclose any use of the composition which they developed and that he discovered a use for the composition which he developed. * * *
>
> "We are unable to agree that there is any patentable distinction between discovering a use and discovering a *new* use for a chemical product developed by experimentation. * * *" (Italics quoted.)

Such an extraordinary holding presents a novel and important question of construction and application of Section 4886, R. S., which ought to be settled by this Court. Furthermore, that holding probably conflicts with a variety of applicable decisions of this Court.

It is prior use of a claimed invention which alone determines that it is wanting in patentable novelty. (*Cantrell* v. *Wallick*, 117 U. S. 689, 695, 29 L. Ed. 1017, 1019; *Smith* v. *Nichols*, 21 Wall. (88 U. S.) 112, 117, 22 L. Ed. 566, 567.)

In *Detrola Radio & Television Corp.* v. *Hazeltine Corp.*, 313 U. S. 259, 268, 85 L. Ed. 1319, 1323, 1324, this Court, having reference to the known usefulness of automatic amplification control for various ends in the prior art, said:

> "* * * But the use of automatic amplification control, whatever the end, is the critical consideration."

The court below failed, therefore, to give effect to a critical consideration involved in the present issue of anticipation,—namely, the conceded lack of any actual or even suggested use for the compositions disclosed in the Hrynakowski and Wood-LaWall references.

This Court, moreover, has demonstrated repeatedly, in its decisions, that the essential feature in a discovered new use of a device, which renders it unpatentable, is that the new use in fact is merely a second use, which has followed

upon a prior old use of the device. (*Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 91, 86 L. Ed. 58, 63; *C. & A. Potts* v. *Creager*, 155 U. S. 597, 608, 39 L. Ed. 275, 279; *County of Fond du Lac* v. *May*, 137 U. S. 395, 406, 34 L. Ed. 714, 718.) In *County of Fond du Lac* v. *May*, last cited, this Court said:

> "* * * The case is one merely of a double use. The mechanism was old in its use * * *."

The holding of the court below, that there is no patentable distinction between discovering a first use and discovering a new use for a chemical product, thus is clearly unsustainable.

But there is an additional and conclusive reason why that holding rests upon an erroneous construction of Section 4886, R. S.: If the mere prior physical existence of a device or composition, for which those skilled in the art have not suggested or found any practical use, is sufficient to anticipate a claim to the first and original use thereof, obviously there is no need for the rule that a new use can never be patentable.

In *Whiteley* v. *Swayne*, 7 Wall. (74 U. S.) 685, 687, 19 L. Ed. 199, 200, this Court said that

> "* * * he is the first inventor and entitled to the patent, who, being an original discoverer, has first perfected and adapted the invention to actual use. Curtis, Patents, sec. 43, p. 37 and notes."

To the same effect is *Seymour* v. *Osborne*, 11 Wall. (78 U. S.) 516, 552, 20 L. Ed. 33, 41.

On the basis of undisputed facts in the record, petitioner submits that he is entitled to a patent, because he first perfected and adapted the claimed invention to actual use.

(e) The court below holds (R. 98) that

> "* * * If appellant's composition has utility,

> the same compositions, as described in the references, must have utility. * * *"

Not only is the court improperly reading into the Hrynakowski and Wood-LaWall publications petitioner's teachings as to the utility of his claimed composition, but the court's holding is in conflict with the settled rule that the mere prior production of a device or composition, where its suitability for any practical use is unrecognized and unappreciated, does not constitute a valid anticipation. (*Tilghman* v. *Proctor,* 102 U. S. 707, 711, 712, 26 L. Ed. 279, 282; *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.,* 261 U. S. 45, 66, 67 L. Ed. 523, 534.)

(f) The court below holds (R. 99) that

> "* * * The patent which appellant seeks is for a composition of matter *as a composition*; not for the concept of using the composition. * * *" (Italics quoted.)

That holding, however, is in conflict with what this Court said in *United States* v. *Dubilier Condenser Corp.,* 289 U. S. 178, 188, 77 L. Ed. 1114, 1119,—namely, that

> "Though the mental concept is embodied or realized in a mechanism or a physical or chemical aggregate, the embodiment is not the invention and is not the subject of a patent. * * *"

To the same effect is *Smith* v. *Nichols,* 21 Wall. (88 U. S.) 112, 118, 22 L. Ed. 566, 567.

Petitioner submits that the many respects in which holdings of the court below in the instant case are in conflict with applicable decisions of this Court or with its clearly expressed views concerning the proper construction to be given to Section 4886, R. S., should lead to allowance of the writ of certiorari.

2. The issue of improper claiming, with reference to

claims 649 and 650, involves questions concerning the correct application of the following provision in Section 4888, Revised Statutes, 35 U. S. C., § 33:

> "* * * and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

As previously pointed out, other than to hold (R. 91, 92) that two clauses in the claims (being recitals I and J, Appendix A, *infra*, pp. 23, 24) are mere statements of result, the court below did little more than to affirm the holding of the Board of Appeals in rejecting claims 649 and 650 "as not properly defining the alleged invention." (R. 100.)

The reasons given by the Board of Appeals for that holding appear in the paragraph beginning at the bottom of page 57 of the record. The characteristics of the nitrogenous polar material, expressed as limitations in each of claims 649 and 650 (recitals G, H, and I, Appendix A, *infra*, pp. 23, 24), are not functional, as held by the Board of Appeals (R. 58), but serve to define the required properties of the polar material, which are but outward expressions of its chemical structure. As is stated in *The Encyclopaedia Britannica* (14th Ed., 1929), Vol. 5, at page 341:

> "* * * The chemist pictures the properties of every substance as being determined by the chemical make-up of its molecules, *i. e.*, by the nature of the atoms which are contained in each molecule of the given substance, and the manner of their arrangement. * * *"

The Board of Appeals also erred in holding (R. 58) that the qualities of petitioner's compositions are defined functionally in each of claims 649 and 650. The quality, for example, of the composition as a non-corrosive germicide

is a resultant of the respective chemical structures and properties of its components, as well as of the chemical behavior of the components toward one another. Similarly, the court below erred in holding (R. 91, 92) that two clauses in the claims (recitals I and J, Appendix A, *infra*, pp. 23, 24) were mere statements of results.

It necessarily follows that the Board of Appeals,—and the court below by its affirming judgment,—in rejecting claims 649 and 650 for improper claiming, have misapplied the provision of Section 4888, R. S. relating to particularity and distinctness in claiming an invention.

Furthermore, those holdings of the tribunals below are probably in conflict with principles of proper claim draftsmanship, as enunciated by this Court. Although this Court stated the matter negatively in *Holland Furniture Co.* v. *Perkins Glue Co.*, 277 U. S. 245, 256, 72 L. Ed. 868, 873, petitioner submits that the following sentence from that case lays down a test for determining the sufficiency of a claim to a composition of matter:

> "* * * The ingredient was thus described, not in terms of its own physical characteristics or chemical properties or those of the product, but wholly in terms of the manner of use of the product. * * *"

Clearly, each of claims 649 and 650 meets that test; for in each claim the composition, as well as the nitrogenous polar ingredient thereof, is defined in terms of its physical characteristics and chemical properties.

In its opinion (R. 96, first sentence) the court noted, but did not thereafter refer to, a thought expressed by the Primary Examiner—presumably the Examiner's contentions (R. 54) that tests would be necessary to determine (a) whether any compound is preponderantly anionoid or cationoid, and (b) whether or not either of claims 649

and 650 would be infringed by the use of a given compound. Those contentions fail to take into account the rule that a claim may be good even though testing be necessary in connection with a particular practice thereof (*Minerals Separation, Ltd.*, v. *Hyde*, 242 U. S. 261, 270, 271, 61 L. Ed. 286, 293); and the rule as to equivalents to which a chemical patent claim is entitled. (*Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605, 608, 609, 94 L. Ed. 1097, 1102, 1103.)

In ending its analysis of the issue of improper claiming the Board of Appeals said (R. 58):

> "* * * The claims are so worded as to include only those nitrogenous material of anionoid character which, when compounded with an appropriate phenol, will yield the desired type of germicide."

Petitioner submits that this statement of the Board is tantamount to a holding that claims 649 and 650 are properly phrased generic claims in the instant application.

3. Petitioner, beginning at page 6 hereof, has shown from the face of the record how the court below held the claims anticipated on the basis of petitioner's admission that 20 per cent of Hrynakowski's mixtures would come within the terms of the claims, whereas the court knowingly disregarded the Primary Examiner's admission (R. 53) that Hrynakowski "* * * does not disclose a use of the composition or any hint of the inventive concept * * *." Petitioner submits that this action of the court below not only introduced material and prejudicial error into the judgment sought to be reviewed, but also constituted such a departure from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision by allowance of the writ of certiorari.

CONCLUSION.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

LEON F. SHACKELL,
Petitioner, Pro Se.

627 East 83rd Street,
Chicago 19, Illinois,
May 9, 1952.

APPENDIX A.

Rejected Claims.

649. A substantially water-free, phenolic, germicidal composition that is adapted as such for direct local application, A

said composition comprising a highly caustic phenol in substantially homogeneous physical admixture with a nitrogenous polar material that is preponderantly anionoid in molecular structure and further characterized B C D E F

(a) by being chemically compatible with the caustic phenol, G

and

(b) by being capable of forming a substantially homogeneous physical system with more than its weight of the caustic phenol; H

said physical system, when so formed and when applied to a substantially dry cutaneous surface, exhibiting a delay in the time of onset of caustic effect of the phenol of at least 100 per cent beyond the time of onset of caustic effect of a control mixture containing the same phenol in the same proportion by weight as in said physical system, but with said nitrogenous polar material being substituted in the control mixture by a substantially nonpolar hydrocarbon of the class consisting of cyclohexane, pinene, p-xylene and a mixture of isomeric xylenes; I

said composition, upon standing in a closed container at room temperature, remaining substantially free from segregation therein of ingredients thereof; J

said composition containing the caustic phenol in an effective germicidal concentration; K

and

said nitrogenous polar material being present in the composition in an amount sufficient to reduce the causticity of the phenol without proportionately reducing its germicidal power. L

650. A substantially water-free, phenolic, germicidal composition that is adapted as such for direct local application, A

said composition comprising a highly caustic phenol in substantially homogeneous physical admixture with a nitrogenous polar material in the form of an amide that is preponderantly anionoid in molecular structure and further characterized B C D E F

(a) by being chemically compatible with the caustic phenol, G

and

(b) by being capable of forming a substantially homogeneous physical system with more than its weight of the caustic phenol; H

said physical system, when so formed and when applied to a substantially dry cutaneous surface, exhibiting a delay in the time of onset of caustic effect of the phenol of at least 100 per cent beyond the time of onset of caustic effect of a control mixture containing the same phenol in the same proportion by weight as in said physical system, but with the amide being substituted in the control mixture by a substantially non-polar hydrocarbon of the class consisting of cyclohexane, pinene, p-xylene and a mixture of isomeric xylenes; I

said composition, upon standing in a closed container at room temperature, remaining substantially free from segregation therein of ingredients thereof; J

said composition containing the caustic phenol in an effective germicidal concentration; K

and

said amide being present in the composition in an amount sufficient to reduce the causticity of the phenol without proportionately reducing its germicidal power. L

651. A substantially water-free, phenolic, germicidal composition that is adapted as such for direct local application, A

said composition comprising a highly caustic phenol in substantially homogeneous physical admixture with a nitrogenous polar material in the form of acetanilid that is preponderantly anionoid in molecular structure and further characterized B C D E F

(a) by being chemically compatible with the caustic phenol, G

and

(b) by being capable of forming a substantially homogeneous physical system with more than its weight of the caustic phenol; H

said physical system, when so formed and when applied to a substantially dry cutaneous surface, exhibiting a delay in the time of onset of caustic effect of the phenol of at least 100 per cent beyond the time of onset of caustic effect of a control mixture containing the same phenol in the same proportion by weight as in said physical system, but with the acetanilid being substituted in the control mixture by a substantially non-polar hydrocarbon of the class consisting of cyclohexane, pinene, p-xylene and a mixture of isomeric xylenes; I

said composition, upon standing in a closed container at room temperature, remaining substantially free from segregation therein of ingredients thereof; J

said composition containing the caustic phenol in an effective germicidal concentration; K

and

said acetanilid being present in the composition in an amount sufficient to reduce the causticity of the phenol without proportionately reducing its germicidal power. L

APPENDIX B.

Specification of Errors to Be Urged.

The United States Court of Customs and Patent Appeals erred:

1. In failing to give effect to controlling doctrines of substantive patent law as announced by the Supreme Court of the United States.

2. In rejecting petitioner's claims on unsubstantial grounds arising from the court's application of arbitrary and artificial rules of interpretation to each of Sections 4886 and 4888, Revised Statutes; although the court assumed that petitioner's development of his claimed composition required the exercise of the inventive faculty. (R. 97.)

3. In holding, without qualification or restriction, that Section 4886, R. S. "in effect, inhibits the granting of a patent for a composition which has been described in printed publications before the invention or discovery was made by the patent applicant." (R. 97.)

4. In holding, without qualification or restriction, that, if a composition merely disclosed, without more, in a prior, non-patent publication "would come within the terms" of an applicant's claims, "it must be 'substantially the same invention'." (R. 97.)

5. In holding that "the composition was made accessible to the public by publication." (R. 98.)

6. In holding that "The references disclose the composition, and it is immaterial whether it resulted from an inventive concept, an accidental discovery, or merely from skill in the art." (R. 98.)

7. In failing to discriminate, in a patent sense, between the "discoveries" disclosed in the reference publications and petitioner's discovery as described in his specification and defined in his claims. (R. 98, 99.)

8. In rejecting petitioner's contentions that the reference publications are not valid anticipations because (a) each lacks any showing or suggestion of practical utility of the compositions disclosed therein; (b) each could not support an application for patent; (c) each furnishes nothing more than a starting point for further experiments and research; and (d) each amounts to nothing more than an account of abandoned experiments.

9. In holding that there is no "patentable distinction between discovering a use and discovering a *new* use for a chemical product developed by experimentation." (R. 99.)

10. In holding that "The patent which appellant seeks is for a composition of matter *as a composition;* not for the concept of using the composition." (R. 99.)

11. In declaring itself "committed to the doctrine that where a product is clearly disclosed in a publication, * * * the disclosure of the composition is sufficient to anticipate a claim therefor." (R. 99.)

12. In holding that the clause in each of claims 649 and 650—which recites a test for a nitrogenous polar material that is preponderantly anionoid in molecular structure—"is a mere statement of result and does not affect the patentability of the claims." (R. 91.)

13. In holding that the clause in each of claims 649 and 650—which recites that the composition, upon standing in a closed container at room temperature, remains substantially free from segregation therein of ingredients thereof—states a result. (R. 91, 92.)

14. In sustaining, in effect, the holding of the Board

of Appeals that three out of four characteristics of the nitrogeneous polar material, which are set forth in each of claims 649 and 650, relate to the qualities of the completed compositions, and that such requirements are therefore functional, and do not constitute a proper definition of the subject matter. (R. 57, 58.)

15. In sustaining, in effect, the Primary Examiner's rejection of claims 649 and 650 as too broad, indefinite and functional on the grounds that "there is no positive way of determining without test whether any compound is predominantly anionoid or cationoid," and that "The claims leave to one skilled in the art only testing as the way to determine whether or not the composition claim is infringed." (R. 54.)

16. In failing to hold that application of the doctrine of equivalents suffices to meet the Examiner's contention that testing would be the only way to determine whether or not either of claims 649 and 650 is infringed.

17. In affirming the decision of the Board of Appeals.

In the Supreme Court of the United States

OCTOBER TERM, 1951

No. 763

LEON F. SHACKELL, PETITIONER

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

Petitioner's application for a patent on a germicide was rejected by a Patent Office examiner and by the Patent Office Board of Appeals. He seeks review by this Court of a decision of the Court of Customs and Patent Appeals affirming the decision of the Patent Office.

While we believe that the decision below is correct and that the questions presented by the petition would not in any event warrant certiorari, petitioner confronts at the threshold the obstacle

that this Court is without jurisdiction to review judgments of the Court of Customs and Patent Appeals in patent or trademark cases. The basis for our view that there is no jurisdiction has been presented to the Court twice this Term—in *Dalton and Cooley* v. *Marzall,* No. 87, certiorari denied, 342 U.S. 818, and in *Thompson* v. *Learned,* No. 496, certiorari denied, 342 U. S. 942—and the Court is respectfully referred to the briefs opposing certiorari in those cases. Our position in a word is that, under *Postum Cereal Co.* v. *California Fig Nut Co.,* 272 U. S. 693, 698-699, which remains applicable today, a decision of the Court of Customs and Patent Appeals in a proceeding of this type is "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes", and that such a decision, presenting no justiciable case or controversy, is beyond the constitutional power of this Court to review. See *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.,* 283 U.S. 858; *McBride* v. *Teeple,* 311 U. S. 649.

Accordingly, it is respectfully submitted that the petition for a writ of certiorari should be denied for the reason that this Court lacks jurisdiction to review the decision below.

PHILIP B. PERLMAN,
Solicitor General.

JUNE 1952.

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